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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,374	11/28/2001	Rudolf Stockhammer	HPBC C-87	1335

7590 09/27/2006

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,374

Applicant(s)

STOCKHAMMER, RUDOLF

Examiner

Edwin C. Holloway, III

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Examiner's Response

1. In response to applicant's amendment filed 7-17-06, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 102 & 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3-8 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle '477 (US 6101477) in combination with Hohle '762 (US 6199762), Oneda (US 5953705) and Asplund (US 5801367).

Hohle '477 discloses a method and apparatus for booking an entitlement such as reserving airline, hotel or rental car using cardholder identification on a data carrier in the form of a smart card or IC card. Communication is provided via access points or terminals 15 that communicate over a telecommunication network 19 shown in fig. 10. Entitlement data may be stored on the card when making the reservation, or upon arrival at the facility, e.g. when the original transaction is off-line. See

Art Unit: 2612

col. 26 line 34 col. 27 line 39. Hohle '477 discloses off-line transactions in col. 12 lines 38-52 and col. 26 lines 59-61 by inputting ID data such as account number by telephone and updating the card from an access terminal with the selected information at a later time, but does not expressly specify details of this operation such as visible data on the carrier.

Hohle '762 discloses a method and apparatus for booking entitlement similar to Hohle '477 and describes "pending transaction" where the user calls a hotel to make a reservation or other transaction using appropriate interface (voice, keypad) over a standard telephone as a "smart card not present" transaction rather than an online transaction using the smart card. The transaction is stored in a pending transaction database and downloaded to the card in a smartcard present transaction at access point 102. See col. 14 line 38 - col. 15 line 5 and col. 8 lines 13-25 and col. 5 lines 25-27.

Oneda discloses an analogous art reservation method with IC card that includes visible account number information also stored in memory in figs. 2A-2B and cols. 7-8.

Asplund discloses an analogous art booking method using a travel pass card with memory storing ID data and display 2 to visibly indicate the data in the memory. See the abstract and col. 2 line 50- - col. 3 line 16. A reservation may be made by

Art Unit: 2612

telephone and the booking data sent to the destination gate. When the traveler arrives at the gate, the unique card ID or serial number (col. 2 line 59) is read and the stored data booked by telephone is loaded into the card. See col. 4 lines 31-46. Therefore, the card is automatically updated and does not require the use of special card reading equipment for making reservations. See col. 1 lines 43-63.

Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Hohle '477 the visible data of Oneda to allow the user to ascertain the card ID or number for use in a smartcard not present or offline transactions of Hohle '477 and Hohle '762 and suggested by Hohle '477 referring to standard smart cards in cols. 1-3 and standard credit cards with account number in col. 5 lines 29-37 that is typically printed on the credit card and use of such card number in a card not present transaction in col. 12. It further would have been obvious for the "card not present transaction" to have included entitlement booking such as a reservation in view of Hohle '762 describing a "card not present transaction" to include reservation and other transaction and defining a "transaction" to be any message including reservation request and ticket request.

Regarding the 7-17-06 amendment to change identification

Art Unit: 2612

data to serial number in claims 1 and 10, serial number would have further been obvious in view of Asplund disclosing a card serial number as unique ID for booking an access entitlement with a smartcard and is suggested by the unique card ID in col. 13 line 15 of Hohle '477 and the serial number in col. 3 lines 61-62 of Hohle '762.

Regarding claim 3, Hohle '477 includes contactless communication in line 33.

Regarding claim 4, Hohle '477 includes a server in claim 14 line 4.

Regarding claim 6, the kiosk, desk or access terminals in Hohle '477 or Hohle '762 may be stationary or mobile.

Regarding claims 7-8, the telephone transaction of Hole '477 and Hole '762 encompasses typical links such as wired and wireless phones that may include connection or interface to a smartcard in col. 4 lines 9-28 of Hohle '762.

Claim 10 would have been obvious for the same reasons applied above to claim 1. Communication to server is provided by "smartcard not present" communication to EDSI in col. 14 lines 39-55 of Hohle '762 where the EDSI includes a server in col. 6 lines 25-31 of Hohle '762.

Claim 11, would have been obvious for the reasons applied above to claim 7.

Art Unit: 2612

Regarding claim 5, communication to only the first terminal would have been obvious in view of Asplund disclosing sending data to a specific destination gate to provide efficient operation.

Claim 12 would have been obvious for the same reasons applied to claim 5.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle '477 (US 6101477) in combination with Hohle '762 (US 6199762), Oneda (US 5953705) and Asplund (US 5801367) as applied above in view of Pinnow (US 4573046). The data carrier on a watch would have been obvious in view of the watch apparatus of Pinnow for convenient access control.

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle '477 (US 6101477) in combination with Hohle '762 (US 6199762) and Oneda (US 5953705) as applied above in view of Tuttle (US 5448110).

Hohle '477 discloses a method and apparatus for booking an entitlement such as reserving airline, hotel or rental car using cardholder identification on a data carrier in the form of a smart card or IC card. Communication is provided via access points or terminals 15 that communicate over a telecommunication

Art Unit: 2612

network 19 shown in fig. 10. Entitlement data may be stored on the card when making the reservation, or upon arrival at the facility, e.g. when the original transaction is off-line. See col. 26 line 34 col. 27 line 39. Hohle '477 discloses off-line transactions in col. 12 lines 38-52 and col. 26 lines 59-61 by inputting ID data such as account number by telephone and updating the card from an access terminal with the selected information at a later time, but does not expressly specify details of this operation such as visible data on the carrier.

Hohle '762 discloses a method and apparatus for booking entitlement similar to Hohle '477 and describes "pending transaction" where the user calls a hotel to make a reservation or other transaction using appropriate interface (voice keypad) over a standard telephone as a "smart card not present" transaction rather than an online transaction using the smart card. The transaction is stored in a pending transaction database and downloaded to the card in a smartcard present transaction at access point 102. See col. 14 line 38 - col. 15 line 5 and col. 8 lines 13-25 and col. 5 lines 25-27.

Oneda discloses an analogous art reservation method with IC card that includes visible account number information also stored in memory in figs. 2A-2B and cols. 7-8.

Regarding claims 13-14, it would have been obvious to one

Art Unit: 2612

of ordinary skill in the art at the time the invention was made to have included in Hohle '477 the visible data of Oneda to allow the user to ascertain the card ID or number for use in a smartcard not present or offline transactions of Hohle '477 and Hohle '762 and suggested by Hohle '477 referring to standard smart cards in cols. 1-3 and standard credit cards with account number in col. 5 lines 29-37 that is typically printed on the credit card and use of such card number in a card not present transaction in col. 12. It further would have been obvious for the "card not present transaction" to have included entitlement booking such as a reservation in view of Hohle '762 describing a "card not present transaction" to include reservation and other transaction and defining a "transaction" to be any message including reservation request and ticket request. Hohle '477, Hohle '762 and Oneda disclose IC or chip card carriers storing identification data and Oneda includes visible indication of the identification data. Hohle '477 includes contactless communication in line 33. Hohle '477 includes a server in claim 14 line 4. The kiosk, desk or access terminals in Hohle '477 or Hohle '762 may be stationary or mobile. The telephone transaction of Hole '477 and Hole '762 encompasses typical links such as wired and wireless phones that may include connection or interface to a smartcard in col. 4 lines 9-28 of Hohle '762.

Further, regarding claim 13-14, the a passive RFID on the smartcard data carrier would have been obvious in the combination applied above further in view of Tuttle disclosing a passive RFID tag (transponder) to substitute for power contacts in order to power RF coil smartcards in col. 3 that is suggested by Hole '477 disclosing contactless cards in col. 3.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 3-14 have been considered but are not persuasive and/or are moot in view of the new ground(s) of rejection.

Regarding claims 1 and 10, the addition of serial number to the claims necessitated a new rejection including the Asplund patent for this limitation. The argument that Hohle '477 requires an access point with card reader for all transactions is not persuasive because Hohle '477 allows offline transactions and Hole '762 teaches that offline or card not present transaction include access entitlement transactions such as reservations and ticket requests. Further, "determining" in claim 1 does not exclude use of an access point with a reader. The argument that applicant does not require a confirmation number is not persuasive because there is nothing to exclude a confirmation number in applicant's claims. Applicant argues that the card must first be read in Hohle '477 because the

Art Unit: 2612

offline transaction only means there is no network connection to the database, while applicant performs a true offline transaction. This argument is not persuasive because Hohle '762 clearly discloses a telephone transaction in col. 14. The argument that the "not present" transaction is lacking in Hohle '477 is not persuasive pending transaction of Hohle '762 that is at least suggested by the offline / not present transactions of Hohle '477. Further, applicant's claims do not exclude an access point because the claims include communication with an access terminal and the access terminal reads the card on arrival corresponding to an access point.

Applicant argues Hohle '762 lacks an offline transaction by conveying visibly read serial number and later comparing it to the electronically read serial number. This argument is not persuasive because col. 10 lines 10-19 of Hohle '762 discloses that phone call transaction where the user enters the card number into a touch tone phone. Obviously, the card number is visible on the card to allow such entry as typically provided in the art. Applicant argues that Hohle '762 does not compare the numbers at arrival because Hohle '762 does not disclose any card identifier. This is not persuasive because col. 10 includes a card number for phone transaction, col. 3 includes a serial number, and includes downloading appropriate information to the

Art Unit: 2612

smartcard in col. 15. Obviously an ID match is required in order to update the appropriate information to the correct card. Applicant argues that Hohle '726 lacks using a smart card ID that is independent from a user ID. This argument is not persuasive because "independent from user ID" is not claimed. Further, Hohle '762 includes a serial number in col. 3, Asplund discloses a serial number used as the identifier for updating transaction information that was requested by telephone in col. 4 lines 40-44, col. 10 of Hohle '762 discloses entering the card number into a touch tone phone as in a typical phone transaction.

The argument that Oneda requires insertion of the card into an access point is not persuasive because Oneda is applied to teach a identification information visible on the card that matches the identification information stored on the IC. This is standard in the art to allow the user to perform a telephone transaction as disclosed in Hohle '762 or Asplund.

The rejections of claims 3-9 and 11-14 are proper for the same reasons discussed above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

Art Unit: 2612

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 571-272-4100 or toll free at 1-866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.


Art Unit: 2612

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (571) 272-4000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308.

EH
9/25/06


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2612